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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,601	01/30/2001	Thomas W. Poplawski	JPM-033	1711
7590		09/13/2011	EXAMINER	
Intellectual Property Department Goodwin/Procter LLP 901 New York Avenue, NW Washington, DC 20001			FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			09/13/2011	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. POPLAWSKI
and KHOON-HONG TAN

Appeal 2010-007613
Application 09/772,601
Technology Center 3600

Before JOSEPH A. FISCHETTI, BIBHU R. MOHANTY, and MICHAEL W. KIM, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-32 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002). Oral arguments were presented on September 8, 2011.

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a system and method for electronic bill presentment and payment (Spec. 1:15-18). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter on appeal¹.

1. A method for effectuating a bill presentment and payment comprising:

maintaining a billing database, the billing database containing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller;

generating an electronic summary of the at least one bill using the detailed billing information, [1] at least one portion of the electronic summary being formatted in the form of a remittance slip;

¹ The Examiners Answer at page 2 has indicated that the Amendment filed after the final rejection has been entered and that the copy of the claims in the Appeal Brief Appendix is correct. The Advisory Action mailed April 23, 2010 stating that the Amendment filed after the final rejection was not entered is therefore considered to be in error and have the incorrect box checked.

[2] generating an electronic notification with respect to the at least one bill, the electronic notification containing the electronic summary and an address through which the billing database may be accessed; and

transmitting the electronic notification to the at least one payer, wherein the at least one portion of the electronic summary is printable to serve as a remittance slip in a traditional method of payment of the at least one bill by the at least one payer, thereby [3] allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Hilt	US 5,465,206	Nov. 7, 1995
Hogan	US 5,699,528	Dec. 16, 1997
Schutzer	US 6,292,789 B1	Sep. 18, 2001
Haseltine	US 6,578,015 B1	Jun. 10, 2003

The following rejections are before us for review:

1. Claims 1-3, 6-9, 17-19, 24-26, and 29-32 are rejected under 35 U.S.C. § 103(a) as unpatentable over Haseltine and Hogan.
2. Claims 4-5, 10-16, 20-23, and 27-28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Haseltine, Hogan, Schutzer, and Hilt.

THE ISSUES

With regards to claim 1 the issue turns on whether the prior art discloses claim limitation [1] and if the combination of references would

have been obvious to meet claim limitation [3]. The remaining claims turn on a similar issue.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

- FF1. Haseltine has disclosed providing a computer-implemented electronic bill to a customer and bill format data over a network (Abstract).
- FF2. Hogan has disclosed using a computer to view electronic bills over the World Wide Web or email (Abstract) and that payment can be made by credit card or a checking account (Figure 4).
- FF3. Hogan also disclosed that the user may print the bills on printers connected thereto (Col. 5:5-9).

ANALYSIS

The Appellants argue that the rejection of claim 1 is improper because the prior art does not teach or suggest claim limitation [1] (Br. 9-13). The Appellants also argue that the references teach away from claim limitation [3] (Br. 13-16, Reply Br. 9-11).

In contrast, the Examiner has determined that rejection of record is proper (Ans. 11-13).

We agree with the Examiner. Claim limitation [1] requires: “at least one portion of the electronic summary being formatted in the form of a

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

remittance slip". We begin with claim construction and note that the Appellants have stated that support for this claim limitation is found in Figures 1-3 in items 125 and 260 (Br. 5). We find nothing in this description that limits the "remittance slip" to not be a standard bill in any way. Further, the Appellants Specification at page 12, lines 3-7 describes that a "printed email 25" sent to the biller "serve[s] as a remittance form ensuring proper crediting of the payer's account". Given the broadest reasonable interpretation in light of the Specification, we see nothing to prevent any billing statement from being a "remittance slip" if mailed in with the payment despite the arguments which have been presented by the Appellants.

Haseltine has disclosed providing a computer-implemented electronic bill to a customer and bill format data over a network (FF1). Hogan has disclosed using a computer to view electronic bills over the world wide web or email and that payment can be made by credit card or a checking account (FF2). Hogan has also disclosed that the user may print the bills on printers connected thereto (FF3). The modification of the system of Haseltine to have the user print out the electronic bill if desired as taught by Hogan is considered an obvious and predictable combination of familiar elements for the advantage of having a paper copy of the bill if desired for payment by mail or for paper records. In this case, one of ordinary skill in the art would readily recognize and infer that a paper copy of any bill could be mailed in with the payment if desired. In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Court stated that when considering obviousness that "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and

creative steps that a person of ordinary skill in the art would employ.” *KSR* at 418. For these reasons the rejection of claim 1 is sustained. The Appellants have presented the same arguments for the remaining claims and the rejection of these claims is sustained for the same reasons given above.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 6-9, 17-19, 24-26, and 29-32 under 35 U.S.C. § 103(a) as unpatentable over Haseltine and Hogan.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 4-5, 10-16, 20-23, and 27-28 under 35 U.S.C. § 103(a) as unpatentable over Haseltine, Hogan, Schutzer, and Hilt.

DECISION

The Examiner’s rejection of claims 1-32 is sustained.

AFFIRMED

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